

ESTTA Tracking number: **ESTTA345116**

Filing date: **04/30/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Certa ProPainters, Ltd.
Granted to Date of previous extension	05/01/2010
Address	150 Green Tree RoadSuite 1003 Oaks, PA 19456 UNITED STATES
Attorney information	Daniel L. Fiore Reger Rizzo & Darnall LLP 2929 Arch Street Cira Centre 13th Floor Philadelphia, PA 19104 UNITED STATES dfiore@regerlaw.com Phone:215-495-6533

### Applicant Information

Application No	77814757	Publication date	03/02/2010
Opposition Filing Date	04/30/2010	Opposition Period Ends	05/01/2010
Applicant	Protect Painters International, LLC 3948 Ranchero Drive Ann Arbor, MI 48108 UNITED STATES		

### Goods/Services Affected by Opposition


Class 037. First Use: 2009/03/05 First Use In Commerce: 2009/03/05  
All goods and services in the class are opposed, namely: interior and exterior residential and commercial painting services

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1815143	Application Date	03/19/1992
Registration Date	01/04/1994	Foreign Priority Date	NONE
Word Mark	CERTA PROPAINTERS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 037. First use: First Use: 1991/12/00 First Use In Commerce: 1991/12/00 painting services; namely, painting residential and commercial buildings

Related Proceedings	91194479 91194474
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Attachments	74256853#TMSN.gif ( 1 page )( bytes ) Notice of Opposition - 77814757.pdf ( 4 pages )(38720 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Daniel L. Fiore/
Name	Daniel L. Fiore
Date	04/30/2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 77814757  
For the Mark PROTECT PAINTERS  
Published in the Official Gazette on March 2, 2010

_____	:	
Certa ProPainters, Ltd.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
	:	
Protect Painters International, LLC	:	
	:	
Applicant.	:	
_____	:	

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Certa ProPainters, Ltd., a corporation organized and existing under the laws of the State of Massachusetts, believes that it will be damaged by the registration of United States Trademark Application Serial No. 77814757 filed on August 28, 2009 (the “Application”) and hereby opposes the same. The grounds for opposition are as follows:

1. Certa ProPainters, Ltd. (“Opposer”) is in the business of both providing painting, decorating and related services to residential and commercial customers, and

providing business management assistance in the establishment and operation of such businesses to others, all in the United States.

2. Opposer owns the distinctive and arbitrary mark CERTA PROPAINTERS and design which is registered on the United States Patent and Trademark Office's Principal Register at No. 1,815,143.

3. Opposer's mark was registered on January 4, 1994 in connection with "painting services; namely, painting residential and commercial buildings" in Class 37, which registration is valid and subsisting.

4. Opposer has continually used and advertised its mark through interstate commerce regulated by Congress since at least 1991 in connection with painting and decorating services for the interior and exterior of residential and commercial buildings.

5. Since at least 1991 Opposer has licensed franchisees to offer such services under its mark, and as of December 31, 2008, there were 319 CertaPro franchisees operating in 43 states, the District of Columbia and Puerto Rico.

6. On August 28, 2009, Protect Painters International, LLC ("Applicant") filed U.S. Application, Serial No. 77814757 for PROTECT PAINTERS NOBODY PROTECTS LIKE PROTECT and design for use in connection with "interior and exterior residential and commercial painting services" and claimed a date of first use of the mark in connection with those services of March 5, 2009.

7. Applicant's mark, when used in connection with the services described in the Application, is confusingly similar to Opposer's mark and is used on services closely related to those of Opposer.

8. Applicant's services move through trade channels similar or identical to the trade channels through which Opposer's services move, and are encountered by many of the same consumers who are purchasers or prospective purchasers of Opposer's services.

9. Applicant's mark comprises a mark which so resembles Opposer's mark previously used in the United States and not abandoned as to be likely, when used on or in connection with the services of Applicant, to cause confusion or to cause mistake or to deceive as to the affiliation, connection, association, origin, sponsorship, endorsement, or approval of Applicant's services by Opposer, to the irreparable damage of Opposer.

10. Any dissatisfaction with Applicant's services offered under its mark will necessarily reflect on and injure the reputation and goodwill associated with Opposer's use of its mark.

11. If Applicant is granted a registration for the mark herein opposed, it will obtain thereby a *prima facie* exclusive right to use its mark, which will damage and injure Opposer, the prior and rightful owner and user.

WHEREFORE, Opposer requests that registration of Application Serial No. 77814757 be denied and this opposition be sustained.

Respectfully submitted,

REGER RIZZO & DARNALL LLP

Date: April 30, 2010

/ Daniel L. Fiore/

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